

AMENDMENT UNDER 37 C.F.R. 1.116**EXPEDITED PROCEDURE****EXAMINING GROUP 2665****PATENT****Application # 09/851,283****Attorney Docket # 1999-0647A (1014-132)****REMARKS**

The Examiner is respectfully thanked for the thoughtful consideration provided to this application. Reconsideration of this application is respectfully requested in light of the foregoing amendments and the following remarks.

Each of claims 1, 6, 8, 10, 16, 18, and 19 has been amended for reasons unrelated to patentability, including at least one of: to explicitly present one or more elements implicit in the claim as originally written when viewed in light of the specification, thereby not narrowing the scope of the claim; to detect infringement more easily; to enlarge the scope of infringement; to cover different kinds of infringement (direct, indirect, contributory, induced, and/or importation, etc.); to expedite the issuance of a claim of particular current licensing interest; to target the claim to a party currently interested in licensing certain embodiments; to enlarge the royalty base of the claim; to cover a particular product or person in the marketplace; and/or to target the claim to a particular industry.

Claims 1-21 are now pending in this application. Each of claims 1, 6, 8, 10, 16, 18, and 19 are in independent form.

The Indefiniteness Rejections

Each of claims 1, 6, 8, 10, 16, 18, and 19 was rejected under 35 U.S.C. 112, second paragraph, as being indefinite. These rejections are respectfully traversed.

The present Office Action fails to establish a *prima facie* case of indefiniteness. To establish a *prima facie* case of indefiniteness it must be determined "whether those skilled in the art would understand what is claimed when the claim is read in light of the specification." *Amgen*,

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Inc. v. Chugai Pharmaceutical Co., Ltd., 927 F.2d 1200, 18 USPQ2d 1016 (Fed. Cir. 1991), *cert. denied*, 502 U.S. 856 (1991); *Miles Laboratories, Inc. v. Shandon Inc.*, 997 F.2d 870, 27 USPQ2d 1123 (Fed. Cir. 1993), *cert denied*, 510 U.S. 1100 (1994); *North American Vaccine, Inc. v. American Cyanamid Co.*, 7 F.3d 1571, 28 USPQ2d 1333 (Fed. Cir. 1993, *cert. denied*, 511 U.S. 1069 (1994); *Geneva Pharmaceuticals, Inc. v. GlaxoSmithKline PLC*, 349 F.3d 1373, 68 USPQ2d 1865 (Fed. Cir. 2003).

Each of claims 1, 6, 8, 10, 16, 18, and 19 recite an "eligibility marker" or "means" indicative that a "destination address" or "packet" "is eligible for overflow routing" "based upon a network policy and at least one of a source port ID, a source IP address, and a destination address." The specification recites an "overflow eligibility marker 56 may be provided in the router 12 to determine combinations of source port IDs, IP addresses, and destination IP addresses are eligible for overflow routing. This may be done via negotiations with customers, network policy, Quality of Service (QoS) parameters, etc." See paragraph 27. No evidence is presented that one of ordinary skill in the art would not be able to understand what is claimed when each of claims 1, 6, 8, 10, 16, 18, and 19 is read in light of the specification.

Thus, the present Office Action fails to establish a *prima facie* case of indefiniteness. Accordingly, reconsideration and withdrawal of each of these rejections is respectfully requested.

The Obviousness Rejections

Each of claims 1-21 was rejected under 35 U.S.C. 103(a) as being unpatentable over Masuda (U.S. Patent No. 6,201,810) in view of Rochberger (U.S. Patent No. 6,594,235). These rejections are respectfully traversed.

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None of the cited references, either alone or in any combination, establish a *prima facie* case of obviousness. "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure." *See* MPEP 2143. Moreover, the USPTO "has the initial duty of supplying the factual basis for its rejection." *In re Warner*, 379 F.2d 1011, 154 USPQ 173, 178 (C.C.P.A. 1967).

Rochberger allegedly recites the "present invention provides a means for detecting, based on an **optimization metric**, attribute or parameter, when a route **falls out of optimization** and, in consequence thereof, triggering a reroute. The reroute is performed only if the new route is more optimal than the current route." *See* col. 11, lines 6-11. Regarding the "optimization metric", the only "[e]xamples of the optimization type" cited by Rochberger are "**Cell Delay Variation (CDV), Available Cell Rate (ACR), Cell Transfer Delay (CTD), Peak Cell Rate (PCR)**". *See* col. 11, lines 23-26.

Each of independent claims 1, 6, 8, 10, 16, 18, and 19 recite an "eligibility marker" or "means" indicative that a "destination address" or "packet" "is eligible for overflow routing" "based upon a network policy and at least one of a source port ID, a source IP address, and a destination address." Rochberger does not expressly or inherently teach or suggest an "eligibility marker" or "means" indicative that a "destination address" or "packet" "is eligible for

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overflow routing” “based upon a network policy and at least one of a source port ID, a source IP address, and a destination address.” Masuda does not overcome the deficiencies of Rochberger.

Thus, even if there were motivation or suggestion to modify or combine the cited references (an assumption with which the applicant disagrees), and even if there were a reasonable expectation of success in combining or modify the cited references (another assumption with which the applicant disagrees), the cited references still do not expressly or inherently teach or suggest every limitation of the independent claims, and consequently fail to establish a *prima facie* case of obviousness.

Because no *prima facie* rejection of any independent claim has been presented, no *prima facie* rejection of any dependent claim can be properly asserted.

Consequently, reconsideration and withdrawal of these rejections is respectfully requested.

Allowable Subject Matter

The following is a statement of reasons for the indication of allowable subject matter:

“none of the references of record alone or in combination disclose or suggest the combination of limitations found in the independent claims. Namely,

claims 1-5 are allowable because none of the references of record alone or in combination disclose or suggest “a memory for storing an eligibility marker, the eligibility marker, wherein the eligibility marker is indicative that a packet of a plurality of packets is eligible for overflow routing based upon a network policy and at least one of a source port ID, a source IP address, and a destination address,

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wherein not all data packets from the plurality of data packets are eligible for overflow routing”;

claims 6-9 are allowable because none of the references of record alone or in combination disclose or suggest “a memory for storing an eligibility marker, the eligibility marker based upon a network policy and at least one of a source port ID, a source IP address, and a destination address, wherein the eligibility marker identifies destination addresses that are eligible for overflow routing, wherein not all destination addresses are eligible for overflow routing”;

claims 10-15 are allowable because none of the references of record alone or in combination disclose or suggest “said memory storing an eligibility marker based upon a network policy and at least one of a source port ID, a source IP address, and a destination address, wherein the eligibility marker identifies destination addresses that are eligible for overflow routing, wherein not all destination addresses are eligible for overflow routing”;

claims 16-17 are allowable because none of the references of record alone or in combination disclose or suggest “second means for identifying the destination addresses that are eligible for overflow routing based upon a network policy and at least one of a source port ID, a source IP address, and a destination address, wherein not all destination addresses are eligible for overflow routing”;

claim 18 is allowable because none of the references of record alone or in combination disclose or suggest “a memory for storing a forwarding table, the forwarding table having entries respectively corresponding to destination addresses in the network and identifying at least two output paths from the

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apparatus for at least some of the destination addresses to enable overflow routing, one of the at least two output paths being identified as a primary path and any other output path being identified as an overflow path, said memory for storing an eligibility marker, the eligibility marker based upon a network policy and at least one of a source port ID, a source IP address, and a destination address, wherein the eligibility marker identifies destination addresses that are eligible for overflow routing, wherein not all destination addresses are eligible for overflow routing”; and

claims 19-21 are allowable because none of the references of record alone or in combination disclose or suggest “a memory for storing an eligibility marker based upon a network policy and at least one of a source port ID, a source IP address, and a destination address, wherein the eligibility marker identifies destination addresses that are eligible for overflow routing, wherein not all destination addresses are eligible for overflow routing.”

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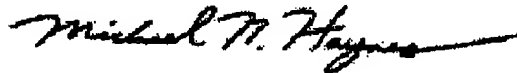
CONCLUSION

It is respectfully submitted that, in view of the foregoing amendments and remarks, the application as amended is in clear condition for allowance. Reconsideration, withdrawal of all grounds of rejection, and issuance of a Notice of Allowance are earnestly solicited.

The Office is hereby authorized to charge any additional fees or credit any overpayments under 37 C.F.R. 1.16 or 1.17 to Deposit Account No. 50-2504. The Examiner is invited to contact the undersigned at 434-972-9988 to discuss any matter regarding this application.

Respectfully submitted,

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